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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,890	02/07/2002	John V. Frangioni	BIDM-P01-004	8688

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EXAMINER

REYES, HECTOR M

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 11/19/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,890

Applicant(s)

FRANGIONI, JOHN V.

Examiner

Hector M Reyes

Art Unit

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-- The MAILING DATE of this communication appears in the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 67 is/are pending in the application.
- 4a) Of the above claim(s) 1 to 16, 18 to 20 and 66 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17, 21 to 36 and 43 to 65 and 67 is/are allowed.
- 6) ☒ Claim(s) 37 to 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Paper Entry

Examiner acknowledges Applicant's Amendment filed on September 4, 2003 as Paper no. 10.

Status of The Claims

Claims 1 to 16, 18 to 20 and 66 had been withdrawn from consideration. Claims 17, 21, 25, 28, 31-35, 37 to 44, 52, 55 and 62 had been amended. New claim 67 had been added.

Rejection Withdrawn

Rejection of claim 17 under the second paragraph of 35 U.S.C. 112 is withdrawn in view of Applicant's amendment and remarks.

Rejection of claim 17 under 35 U.S.C. 102 (b) as being anticipated by Valiaeva et al J. Organic Chemistry, 2001, vol. 66 pages 5146-5154 or Tokutake et al, Bioorganic & Medicinal Chemistry, vol. 6, no. 10 pages 1935-1953 (1998) or Katoh et al, Bioorganic & Medicinal Chemistry, vol. 6 no 13, pages 1437-1442 (1996) are withdrawn in view of Applicant's Remarks.

New Rejections Necessitated by Amendment

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 37 recites the limitation "The compound of claim 17 wherein the Boron addend is carborane". There is insufficient antecedent basis for this limitation in the claim. Claim 17 lacks a boron atom presence in its structure.

Claim 38 recites the limitation "The compound of claim 17 wherein said chemotherapeutic agent is..." There is insufficient antecedent basis for this limitation in the claim. Claim 17 has no reference of a chemotherapeutic agent.

Claim 39 recites the limitation "The compound of claim 17 wherein the said protein synthesis inhibitor is...". There is insufficient antecedent basis for this limitation in the claim. Claim 17 describes no protein or protein synthesis.

Claim 40 recites the limitation "The compound of claim 17 wherein R is a prodrug..." There is insufficient antecedent basis for this limitation in the claim. Claim 17 does not contain a prodrug in its structure.

Claim 41 recites the limitation "The compound of claim 17 wherein the said cytotoxic **toxin** ...". There is insufficient antecedent basis for this limitation in the claim. Claim 17 describes no toxin in structure of compound II.

Claim 42 recites the limitation "The compound of claim 17 wherein the said enzyme that converts prodrug...". There is insufficient antecedent basis for this limitation in the claim. Claim 17 describes no enzyme or prodrug at all.

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ALLOWABLE SUBJECT MATTER

Claims 17, 21 to 36 and 43 to 65 and 67 are considerate allowable because no prior art disclosing compound described in claim 17 as compound II was found disclosed in the prior art.

CONCLUSION

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Hector M. Reyes, Ph. D. JD
Reg. # P 54,846
AU 1625
November 14, 2008

Alan L. Rotman
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